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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,890	11/14/2003	Steven T. Berger	BERGIB/101/US	1122
2543	7590	05/04/2006	EXAMINER	
ALIX YALE & RISTAS LLP 750 MAIN STREET SUITE 1400 HARTFORD, CT 06103			ANDERSON, CATHARINE L	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/713,890

Applicant(s)

BERGER ET AL.

Examiner

C. Lynne Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 17 February 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of the system of Bolden with the teaching of Hagele fulfills all the limitations of Claim 1.

In response to applicant's argument that Bolden fails to disclose the discharge outlet and lid retractor extending at substantially equal angles and being parallel to one another, it is noted that Bolden shows in figure 5 the discharge outlet and lid retractor being substantially parallel along a portion of the length of the lid retractor.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 19-21, 23-25, and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolden (6,090,086).

Bolden discloses a system for delivering a drop of liquid to an eye, as shown in figure 1B, comprising a receiver 14 connected to a transfer portion 30. The transfer portion 30 includes a capillary tube, as shown in figure 3, having a lower discharge outlet 32. A lid retractor 24 is adjacent the discharge outlet 32, and when pressed against the lower lid of the user, forms a cul-de-sac to receive the drop of liquid, as shown in figure 1B. The discharge outlet 32 and at least a portion of the lid retractor 24 extend at substantially equal angles, and are therefore substantially parallel, as shown in figure 5. The device is hand engageable and comprises a liquid flow means 30 for transporting liquid, as shown in figure 1B.

With respect to claim 20, the liquid flow means 30 comprises a capillary tube, as shown in figure 3.

With respect to claim 21, the device further comprises a receiver 14, as shown in figure 3.

With respect to claim 23, the apparatus comprises a manually held instrument 12, as shown in figure 1B, comprising a lid retractor 24 and a liquid conveyor 30.

With respect to claim 24, the liquid conveyor 30 comprises a capillary tube, as shown in figure 3.

With respect to claim 25, the device further comprises a receiver 14, as shown in figure 3.

With respect to claim 27, the method of depositing a drop of liquid into the eye of a subject comprising providing an instrument, pressing the instrument against the lower lid, and advancing a drop of liquid in the instrument to a discharge end, is disclosed in column 3, lines 10-30.

With respect to claim 28, the instrument 10 is first pressed against the lower lid 6 before a drop 5 of liquid is advanced to the discharge end and dropped into the cul-de-sac between lower lid 6 and eye 2, as shown in figure 1B.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolden (6,090,086) in view of Hagele (6,041,978).

Bolden discloses all aspects of the claimed invention with the exception of the lower end portion of the capillary tube being bent at an angle. Bolden discloses a system for delivering a drop of liquid to an eye, as shown in figure 1B, comprising a receiver 14 connected to a transfer portion 30. The transfer portion 30 includes a capillary tube, as shown in figure 3, having a lower discharge outlet 32. A lid retractor 24 is adjacent the discharge outlet 32, and when pressed against the lower lid of the user, forms a cul-de-sac to receive the drop of liquid, as shown in figure 1B.

Hagele teaches the use of the capillary tube to transport a drop of liquid from a container to a patient's eye, as shown in figure 1. The capillary tube 130 is bent, as shown in figure 2. Bending the capillary tube allows the device to be used without having to tilt the patient's head, as disclosed in column 3, lines 11-13.

It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the capillary tube of Bolden with a bend, as taught by Hagele, to allow the device to be used without having to tilt the patient's head.

With respect to claim 2, the receiver 14 has a funnel shape and receives liquid from a container 19, as shown in figure 3.

With respect to claim 3, the capillary tube has a smooth inner surface, as shown in figure 3.

With respect to claim 6, the lid retractor 24 comprises a pad, as disclosed in column 4, lines 53-54, which is a soft substance.

With respect to claims 7 and 8, the receiver, transfer portion, and lid retractor are made of plastic, as shown in figure 3.

With respect to claim 9, the receiver 14 has an upper end portion formed as a flexible bulb 19, as shown in figure 3.

With respect to claim 10, the device is designed to be used with one hand, as disclosed in column 2, lines 50-53, and therefore is able to be engaged by the thumb and middle finger of one hand.

With respect to claims 11-14, two rods 20 and 46 extend from opposite sides of the capillary tube, as shown in figure 7, and are fully capable of being engaged by the thumb and middle finger.

With respect to claim 15, the end portion 32 has a conical shape, as shown in figure 3.

With respect to claim 16, Bolden discloses all aspects of the claimed invention with the exception of an extension on the capillary tube to guide the flow of the drop of liquid. Hagele teaches the use of the capillary tube to transport a drop of liquid from a container to a patient's eye, as shown in figure 1. The capillary tube 130 comprises at its end an extension 137, as shown in figure 2. The extension provides a place for the drop of liquid to form, and increases safety of the device, as disclosed in column 4, lines 26-34. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the capillary tube of Bolden with an extension, as taught by Hagele, to provide a place for the drop of liquid to form, and increase the safety of the device.

With respect to claim 17, teeth 15 are dimensioned to grip a tip of a container 12 of liquid, as shown in figure 3.

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolden (6,090,086) in view of Hagele (6,041,978), and further in view of Hanley (6,869,421).

Bolden, as modified by Hagele, discloses all aspects of the claimed invention with the exception of a one-way valve. Hanley teaches the use of a one-way valve in a

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system for delivering a drop of liquid to an eye wherein the one-way valve is positioned between a receiver containing liquid and a capillary tube for dispensing a drop of liquid, as shown in figures 1A and 1B. The one-way valve prevents liquid from returning to the receiver from the capillary tube, as disclosed in column 5, lines 35-45. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the eye drop system of Bolden with a one-way valve, as taught by Hanley, to prevent liquid from returning to the receiver from the capillary tube.

Claims 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolden (6,090,086) in view of Hanley (6,869,421).

Bolden discloses all aspects of the claimed invention with the exception of a one-way valve. Hanley teaches the use of a one-way valve in a system for delivering a drop of liquid to an eye wherein the one-way valve is positioned between a receiver containing liquid and a capillary tube for dispensing a drop of liquid, as shown in figures 1A and 1B. The one-way valve prevents liquid from returning to the receiver from the capillary tube, as disclosed in column 5, lines 35-45. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the eye drop system of Bolden with a one-way valve, as taught by Hanley, to prevent liquid from returning to the receiver from the capillary tube.



***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (571) 272-4932. The examiner can normally be reached on Monday through Friday.

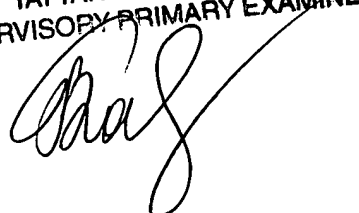
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CMA  
cla  
April 28, 2006

TATYANA ZALUKAEVA  
SUPERVISORY PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Tatyana', is written over the printed name and title of the examiner.